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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,386	05/10/2001	Steven L. Roberds	00133.US1	5508

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EXAMINER

PAK, MICHAEL D

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 10/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/852,386

Applicant(s)

ROBERDS ET AL.

Examiner

Michael Pak

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-116 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:  
  
Groups 1-39, Claims 1-22, 27-30, 64-68, 75-88 drawn to an isolated nucleic acid molecule of SEQ ID NO:1-39 for each group, expression vector, host cell and method of producing a polypeptide, classified in class 435, subclass 69.1. Each group 1-39 is drawn to a single polynucleotide of SEQ ID NO:1-39, respectively.  
  
Group 40--78. Claims 23-24, drawn to antisense, classified in class 536, subclass 24.5. Each group 40-78 is drawn to a single antisense of SEQ ID NO:1-39, respectively.  
  
Group 79--117. Claims 25-26, drawn to a composition, classified in class 514, subclass 44. Each group 79-117 is drawn to a single antisense of SEQ ID NO:1-39, respectively.  
  
Group 117--155. Claims 30-35, 74, 89-94, 116, drawn to an isolated polypeptide and composition of SEQ ID NO:40-78 for each group, classified in class 530, subclass 350. Each group 117-155 is drawn to a single polypeptide of SEQ ID NO:40-78, respectively.  
  
Group 156--194. Claims 36-38, 95-96, drawn to an isolated antibody and composition of SEQ ID NO:40-78 for each group, classified in class 530, subclass 387.1. Each group 156-194 is drawn to a single polypeptide of SEQ ID NO:40-78, respectively.

Group 195--233. Claims 39, 97, drawn to method of inducing immune response with SEQ ID NO:40-78 for each group, classified in class 424, subclass 185.1. Each group 156-194 is drawn to a single polypeptide of SEQ ID NO:40-78, respectively.

Group 234--272. Claims 40-43, 98-99, drawn to method of identifying a compound with SEQ ID NO:40-78 for each group, classified in class 436, subclass 501. Each group 156-194 is drawn to a single polypeptide of SEQ ID NO:40-78, respectively.

Group 273. Claims 44, 100, drawn to a compound, classification cannot be determined because no structure is provided.

Group 274--312. Claims 45-46, 101, drawn to a method of binding nucleic acid, classified in class 435, subclass 6. Each group 274-312 is drawn to a single nucleic acid of SEQ ID NO:1-39, respectively.

Group 313. Claims 47, 102, drawn to a compound, classification cannot be determined because no structure is provided.

Group 314--353. Claims 48-51, 69-73, 103-104, 111-115, drawn to method of identifying a compound with SEQ ID NO:40-78 for each group, classified in class 435, subclass 7.2. Each group 156-194 is drawn to a single polypeptide of SEQ ID NO:40-78, respectively.

Group 354. Claims 52, 105, drawn to a compound, classification cannot be determined because no structure is provided.

Group 355--393. Claims 53-55, drawn to a method of identifying animal homolog, classified in class 435, subclass 91.2. Each group 355-393 is drawn to a single nucleic acid of SEQ ID NO:1-39, respectively.

Group 394--432. Claims 56-61, 63, 106, 108, drawn to a method screening, classified in class 204, subclass 182.8. Each group 355-393 is drawn to a single nucleic acid of SEQ ID NO:1-39, respectively.

Group 433--472. Claims 62, 107, drawn to a Kit, classified in class 536, subclass 24.41. Each group 433-472 is drawn to a single nucleic acid of SEQ ID NO:1-39, respectively.

The inventions are distinct, each from the other because of the following reasons.

The products of inventions Group 1-194, 273, 313, 354, and 433-472 are distinct each from the other, because they are drawn to products having materially different structures and functions.

The methods of inventions 195-272, 274-312, 314-353, and 355-432, are distinct, each from the other, because they are drawn to processes having materially different process steps, which are practiced for materially different purposes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, separate search requirements, and different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Michael D. Pak*

Michael Pak  
Primary Patent Examiner  
Art Unit 1646  
25 September 2003